



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,454	06/23/2003	Robert Wiley	102767-0027	9349
21125	7590	04/20/2004	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			THOMPSON, GREGORY D	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,454

Applicant(s)

WILEY, ROBERT

Examiner

Gregory D Thompson

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 13-35 is/are rejected.
- 7) ☒ Claim(s) 6 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/01/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. All prior art in parent S.N 09/899,512 has been considered.

Claims 1-35 filed in Serial Number 10/602,454 are exact duplicates to claims 1-35 filed in parent serial number 09/899,512.

Therefore, listed below are some examples of minor informalities such as inconsistent terminology. Claim 2, line 1 language of "whereof" should be "wherein". Claims 3, 4, 15, "one aperture" should be "one air flow aperture".

Claim 16 depends on claim 16. Change dependency to claim 15. Claim 25, line 3 language of "an air flow aperture "should be changed to" at least one of the air flow apertures". Claim 26, line 3 language of "mouting" should be "mounting". Line 6 language of "rack" should be "the mounting rail". Line 7 language of "rack" should be "frame". Line 8, language of "slide" should be and "slide-rail assembly".

Claim 19, lines 6-7 recites "the rail and the track each have a plurality of air flow apertures" while claim 2 lines 1-2 recite "the air flow aperture of a least one of the rail, the track" which is not consistent language with claim 19.

Please flow amendment filed 12/13/02 in parent serial number 09/899512 to clear up all minor informalities in instant case.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 3-5, 7, 9-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Zenitani et al.

The chassis slide comprises a rail 11 and track 10 that are slidably engaged with one another.

The air flow apertures would be 21 in the rail 11 and track 10. The chassis or module 2 and rack is 60. The track 10 and rail 11 are adapted to be coupled to rack 60 by backboard 3. The rail 11 is adapted to be fixed (broad term) to the track 10 by elements 22(22a); 16 (16a) to prevent slidable movement of the rail 11 with respect to the track 10.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zenitani in view of Kerrigan et al.

Zenitane fails to teach perforations for air flow.

Kererigan et al disclose perforations 211, 213 for air flow in enclosures, chassis 13, 15 that are slide together.

Therefore, considered obvious to one skilled at the time of the invention to construct the air flow aperture 21 of at least one rail 11 or track 10 into a plurality of perforations as taught by Kerrigan to cause an increase in air flow volume through the rail 11 or track 10 thereby reducing the possibility of overheating and component failure.

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis

Art Unit: 2835

added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 26-35 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 18-27 of prior U.S. Patent No. 6,590,768. This is a double patenting rejection.

Claims 26-35 would have to be amended to clear up minor informalities as amended by amendment filed 12/13/02 in Parent S.N. 09/899,512 would then be exact duplicates.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-5, 7-11, 13-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,590,768. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the claim limitations of claims 1-5, 7-11 of instant case are fully met by the claim limitations of claims 1-8 of the patent. For example, in claim 1 of instant case the limitation of the chassis slide comprising a rail and track that are slidably engaged with one another telescopes movement out of the rack, the rail and track each having at least one air flow aperture for facilitating a passage of air through the chassis slide is fully met by the claim limitation found in claims 1 and 5, lines 1-4, 7-9; lines 1-3, 6-8, respectively.

Claims 2-4 (clearing up the informalities) of instant case would be act duplicates to claims 2-4 of the patent with their claim limitation(s) fully met by claims 2-4 of the patent.

Claims 5, 11 limitations of instant case would be fully met by claim limitation(s) in lines 1-2; 5-7 of claim 1 and lines 1-2; 4-6 of claim 5 of the patent, respectively.

Claims 9-10 limitation(s) of instant case would be fully met by limitation(s) of claims 7-8 of the patent sine they are exact duplicates of claims 9-10.

Claims 13-18 of instant case would be fully met by claims 9-12 of the patent. For example, the limitation of "a module disposed in a chassis, a rail coupled to the chassis, a track coupled to a rack, the rail and track being slidably engaged, at least one air flow aperture in the rail the track and a portion of the chassis for facilitating a passage of air through the chassis" in claims 13-18 is fully met by the claim limitation(s) of claims 9-18 of the patent, respectively.

Claims 19-25 of instant case would be fully met by claims 13-17 of the patent. For example, the limitation "a digital data processing apparatus having a module

Art Unit: 2835

disposed in a chassis, a rail coupled to the chassis, a track coupled to a rack, the rail and track being slidably engaged with one another, the rail and track each having a plurality of air flow apertures, a plurality of perforations, at least one aperture of the rail, the track, and the chassis are substantially aligned with one another, the rail and track/rack adapted to be fixed to prevent slidable movement, retention clip, chassis includes at least one vent opening at a rear portion of a side wall " in claims 19-25 is fully met the claim limitations of claims 9-12 of the patent, respectively.

8. Claims 6, 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The cited art does not teach nor suggest the track including a mounting clip to fix the track to the rack and the rail including a retention clip for fixing the rail to the rack as claimed in claims 6, 12.

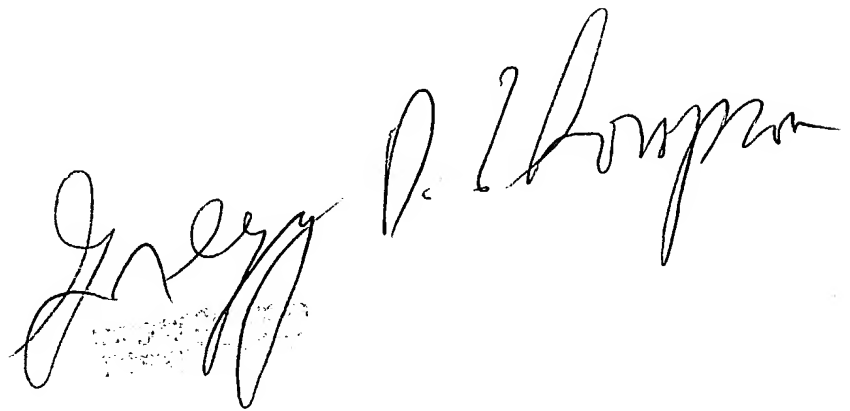
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory D Thompson whose telephone number is (571)272-2045. The examiner can normally be reached on (571)272-2045 from 6:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Schubert E Darren, can be reached on (571)272-2800 ext(35)***. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 10/602,454
Art Unit: 2835

Page 7

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Gregory D. Thompson". The signature is written in a cursive style with a large, stylized "G" and "T".